

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RONALD P. SANSONE

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Appeal No. 2007-1715  
Application No. 10/033,224  
Technology Center 3600

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Decided: April 30, 2007

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Before HUBERT C. LORIN, ANITA PELLMAN GROSS, and  
LINDA E. HORNER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 3 and 5-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,485,369

to Nicholls in view of U.S. Patent No. 5,890,138 to Godin.<sup>1</sup> 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

We AFFIRM.

The Brief<sup>2</sup> separately argues the following groups of claims:

- Claims 3, 15, and 17 (Br. 16-18);
- Claims 5-9 and 12-14 (Br. 18-20);
- Claim 10 (Br. 20-21);
- Claim 11 (Br. 21); and,
- Claim 16 (Br. 21-22).

#### I. Claims 3, 15, and 17

Pursuant to the rules, the Board selects representative claim 3 to decide the appeal with respect to this group of claims. 37 C.F.R. § 41.37(c)(1)(vii) (2006). It reads as follows:

3. A method of returning a weight from a weight field of a database wherein said database has at least one data field for storing a set of data relative to a corresponding article, packing material, and container, and wherein said set of data comprises at least said weight field, the method comprising the steps of:

(a) initiating a cost determining routine in a shipping system application at a first node;

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<sup>1</sup> Claims 1, 2 and 4 have been cancelled.

<sup>2</sup> Our decision will make reference to Appellant's Appeal Brief ("Br.," filed 28 September 2006) and the Examiner's Answer ("Answer," mailed 12 December 2006).

(b) entering a description of said corresponding article, said packing material, and said container into a first data field of said rate determining routine;

(c) transmitting a query from said routine to said database for a weight associated with said corresponding article, said packing material, and said container;

(d) returning said weight to said routine; and

(e) displaying the cost to ship the article, packing material and container.

A. Issue

The Examiner finds that “Nicholls et al. anticipate all the substantive elements of claims 3 and 5-17, except that, while Nicholls et al. do disclose scanning the UPC barcode of an article being picked in a warehouse for shipping, Nicholls et al. do not disclose using the scanned UPC barcode as a key value to look up the weight of the item in a database, thereby obviating the need for a scale to weigh the item.” Answer 4.

The Examiner finds that the difference between the claimed subject matter and Nicholls is the subject matter of claim steps (c)-(e):

(c) transmitting a query from said routine to said database for a weight associated with said corresponding article, said packing material, and said container;

(d) returning said weight to said routine; and

(e) displaying the cost to ship the article, packing material and container.

The Examiner relies on Godin to show requesting an item’s weight from a computer database and using that weight to calculate shipping costs. Examiner explains:

... Godin et al. disclose a shipping method which indeed uses the UPC barcode value for an item to look up the weight of the item in a computer database in order to use that weight value as one of the necessary inputs to calculate shipping costs for the item, and the system of Godin et al. works over the Internet.

Answer 4-5.

The Examiner finds

[I]t would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system and method of Nicholls et al. so as to determine the weight of an item to be shipped by using the UPC barcode to look up the weight of the item in a database rather than by measuring the weight with a scale, as well as to work over the Internet, all in accordance with the teachings of Godin et al., in order to eliminate the need to re-measure the weight of identical items each time one of those identical items was being shipped, and in order to work with any terminal in the world connected to the Internet, thereby saving time and effort.

Answer 5. Accordingly, the Examiner contends that one of ordinary skill in the art given Godin would have been led to modify the Nicholls method to include claim steps (c)-(e).

Appellant does not dispute Examiner's characterization of Nicholls or the Examiner's characterization of the difference between the claimed invention and Nicholls. Appellant disputes the relevance of Godin. Appellant argues that "Godin discloses a product weight as part of the shipping cost but does not disclose anything about the packing material and container." Br. 17. Appellant argues that "Godin discloses a reverse auction system in which the weight of the product is part of the shipping cost. Godin does not disclose how to determine the weight of

the package and, therefore, the cost of mailing the package.” Br. 17. Appellant further argues that

Neither Nicholls nor Godin, taken separately or together, discloses or anticipates the system and method claimed by Appellant in claims 3-17, namely, a system and method of returning a weight from a weight field of a database wherein said database has at least one data field for storing a set of data relative to a corresponding article, packing material, and container, and wherein said set of data comprises at least said weight field.

Br. 17. Accordingly, Appellant contends that the prior art does not disclose steps (c)-(e) of claim 3 and therefore contends that one of ordinary skill in the art given Godin would not have been led to modify the Nicholls method to include claim steps (c)-(e). Br. 17.

The issue is whether the evidence would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. More specifically, the issue is whether one of ordinary skill in the art given Godin would have been led to modify the Nicholls method to include claim steps (c)-(e).

#### B. Facts

The record supports the following findings of fact by a preponderance of the evidence.

1. The claims are directed to a method involving a cost determining routine in a shipping system application and a database, the method comprising initiating the routine (step (a)), entering a description of an article, the material packing it, and the container holding it, in a data field in the routine (step (b)), transmitting a query

from the routine to the database for a weight associated with the article/packing/container (step (c)), returning the weight to the routine (step (d)), and displaying the cost to ship the article/packing/container (step (e)).

2. We find in agreement with the Examiner, and not disputed by Appellant, that Nicholls discloses a method comprising the steps of

(a) initiating a cost determining routine in a shipping system application at a first node; [and,]

(b) entering a description of said corresponding article, said packing material, and said container into a first data field of said rate determining routine.

3. Nicholls discloses a system for automating the shipping of goods comprising an order processing station (Fig. 1, 22), a packaging station (Fig. 1, 24), and a shipping station (Fig. 1, 26). The system includes a logistics system application that can be run on a computer at any of the stations (col. 5, ll. 5-10). The application has an interface with fields that accept a user's inputs (Figs. 4A-4L and col. 7, ll. 22-33), one of which is a description of a package to be shipped (Fig. 4A and col. 7, ll. 52-55). The description may also include its weight. See Fig. 4. Input may be accomplished by either the operator typing or scanning the information into the system or "the system may be set to look up the associated information from one or more local and remote sources such as databases ...," col. 7, ll. 62-66. Another field that may be included in the application's interface is an adjustment to a shipper's rates where adjustments may be qualified by weight range (col. 8, ll. 42-55). Finally, Nicholls discloses a weigh scale (col. 9, ll. 46-63; Fig. 4G-4I).

4. We find in agreement with the Examiner, and not disputed by Appellant, that the difference between the claimed subject matter and Nicholls is the subject matter of claim steps (c)-(e):

- (c) transmitting a query from said routine to said database for a weight associated with said corresponding article, said packing material, and said container;
- (d) returning said weight to said routine; and
- (e) displaying the cost to ship the article, packing material and container.

Specifically, Nicholls does not appear to show the application querying for a weight from the database and displaying a cost to ship the article/packing/container.

5. Godin discloses a database that includes a field corresponding to “a product weight which is used as part of the shipping cost” (col. 3, l. 38). Godin further discloses applications which retrieve data from the database (col. 5, ll. 41-45) and display results on a webpage, one of which is freight cost (col. 7, ll. 8-9 and Fig. 12).

### C. Principles of Law

1. A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

2. Claims are given the broadest reasonable construction consistent with the specification. *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).
3. “Many of appellant's arguments fail from the outset because, as the solicitor has pointed out, they are not based on limitations appearing in the claims.” *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

#### D. Analysis

We have carefully considered the record and find that one of ordinary skill in the art with Nicholls and Godin in hand would have been led to modify the Nicholls logistics system application to retrieve the weight of a corresponding article/packing/container from a database, return that weight to the application, and display the cost.

Nicholls discloses a database which receives as an input a package's weight as well as information about shipping costs. FF 3.

Furthermore Nicholls discloses a weigh scale which one of ordinary skill in the art would understand has, as its objective, to weigh a package prior to shipping it. Since it is generally well known that there is a cost associated with shipping a package and that a package's weight is a factor in the shipping cost, one of ordinary skill in the art reading Nicholls would foresee the logistics system disclosed therein providing a shipping cost based on the weight of the package stored in the database.

Godin discloses a system involving an application retrieving data from a database and displaying results on a website; weight being one of the data and



shipping costs being one of the types of information the website displays. FF 5. Since previous knowledge of the good's weight is necessarily required before the good's shipping cost can be displayed on the website, Godin implicitly discloses retrieving weight data for a good from the database prior to displaying the good's shipping cost on the website. This operation parallels claim steps (c)-(e).

Given the well-established connection between weight and the shipping cost, one of ordinary skill in the art with Godin in hand would be led to modify the Nicholls system application so as to display a package's shipping cost based on the weight inputted in the database. It would have been obvious to one of ordinary skill in the art to modify the Nicholls logistics system application so as to retrieve the weight of a package, i.e., an article/packing contents/container, from the database, return that weight to the application, and display the shipping cost per the Godin method. It would also have been obvious to one with ordinary skill in the art to query the Nicholls database for weight information because it is generally known that weight information is used to calculate shipping costs.

Appellant argues that Godin discloses a product weight as part of the shipping cost but not the packing material. Br. 17. Appellant also argues that neither Nicholls nor Godin discloses a method of returning a weight from a weight field of a database wherein the database has at least one data field for storing a set of data relative to a corresponding article, packing material, and container, and wherein said set of data comprises at least said weight field. Br. 17. Agreement with these arguments requires one to read in to the claims a step of providing the database with three separate data fields for the weights of each of the article,

packing material, and container. The claims do not so require. They require only that the database have “a weight associated with said corresponding article, said packing material, and said container” (claim 3). A single weight value of a package, such as suggested in Nicholls, can meet that limitation. Accordingly, because it is not commensurate in scope with what is claimed, Appellant’s argument is not persuasive as to error in the rejection.

The rejection is affirmed.

#### E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting claims 3, 15, and 17 over the prior art.

#### Claims 5-9 and 12-14

Pursuant to the rules, the Board selects representative claim 5 to decide the appeal with respect to this group of claims. 37 C.F.R. § 41.37(c)(1)(vii) (2006). It reads as follows:

5. A method of providing for weight-based determinations of one or more articles to be shipped, the method comprising the steps of:
  - a) initiating a cost determining routine in a shipping system application at a first node;
  - b) entering a code or a description of each one of said one or more articles into a first data field of said routine;
  - c) entering a code or a description of the container in which the articles are going to be shipped;
  - d) transmitting a query from said routine to a database located at a second node for a weight associated with said each one of said one or more articles and said container;

- e) returning said weight to said routine for use in calculating a cost for shipping said each of said one or more articles and said container;
- f) entering said weight into a second data field of said shipping system application as an input parameter; and
- g) determining said cost for shipping said each of said one or more articles and container based upon a set of one or more input parameters.

A. Issue

The Examiner's findings are largely those summarized in the Issue section for the rejection of claims 3, 15, and 17 above.

Appellant repeats the arguments summarized in the Issue section for the rejection of claims 3, 15, and 17 above, except that Appellant states, without further explanation, that the cited art does not disclose steps d), e), f), and g), and adds the following:

Furthermore, the cited art does not disclose or anticipate the query disclosed by Appellant in:

Line 12 – line 19 of Page 20 of Appppellant's [sic, Appellant's] specification read as follows:

"The next three subscreens (305, 307 and 309) provide the numeric and text information that enables the present invention to operate. Subscreen 305 contains data entry lines labeled F1, F2 and more. Each line has fields for both UPC code assigned to the contents item, as printed on its label, or found in its description. The "F" lines are filled in with either the UPC or a description until all the items are accounted for. The next subscreen 307 deals with the mail piece container. At least one "G" line must be selected, and either the UPC number entered or the description. The next subscreen 309 deals with the packing and tape used to form the mail piece/container. At least one "H" line must be selected, and both the UPC number entered and a description of what was consumed."

Br. 20. Appellant does not address whether the prior art meets the limitations of steps a)-c) and therefore does not dispute the Examiner's position that that they are suggested by the prior art.

The issue is whether the evidence would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

#### B. Facts

We incorporate herein the facts set forth in the Facts section for the rejection of claims 3, 15, and 17 above and add the following fact, all of which the record supports by a preponderance of the evidence.

1. The subject matter of claim 5 differs from that of claim 3 in calling for the entering of codes or descriptions of the article and container in which the article is to be shipped (steps a)-c)) and providing for a database at a second node to which a query is sent from the routine for a weight associated with the article and container (i.e., steps d)-f)).

#### C. Principles of Law

We incorporate herein the Principles of Law set forth in the Principles of Law section for the rejection of claims 3, 15, and 17 above and add the following:

1. "The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term "*prima*

*facie* case” refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d, 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

#### D. Analysis

We incorporate herein the analysis set forth in the Analysis section for the rejection of claims 3, 15, and 17 above and add the following comment.

We are not persuaded that Appellant has shown error in the rejection.

Appellant argues that the cited prior art does not disclose steps d)-g) but does not explain why the Examiner was wrong in finding otherwise. Once the Examiner has presented what he/she believes is a *prima facie* case of obviousness, the burden of coming forward with evidence or argument shifts to the applicant. Here, without more, the statement expressing that the prior art does not disclose claimed subject matter is insufficient to overcome the *prima facie* case of obviousness.

Appellant also directs our attention to a passage at line 12 – line 19 of page 20 of the Specification and argues that the cited art does not disclose or anticipate the query disclosed by Appellant. However, a *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the

art to combine the relevant teachings of the references to arrive at the claimed invention, not statements made in the Specification. Furthermore, it is unclear to us what Appellant means to say in directing our attention to that passage. The relationship between the passage and the claims is not explained. Much of what is said in that passage is not in the claims. For example, the passage speaks of subscreens and UPC code, neither of which is a limitation in the claims. Accordingly, Appellant's argument is unpersuasive as to error in the rejection.

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting claims 5-9 and 12-14 over the prior art.

Claim 10

Claim 10 reads as follows:

10. The method claimed in claim 5, further including the steps of:  
entering a code or a description of the packing material that is  
included in the container to be shipped; and  
determining the cost for shipping the packing material.

A. Issue

Appellant argues that “[t]he Examiner has not cited any art in the context of the claimed invention that shows that it would have been obvious to: enter a code or a description of the packing material that is included in the container to be shipped; and determining the cost for shipping the packing material.” Br. 21. The

issue is whether it would have been obvious to one of ordinary skill in the art to provide a field in the prior art database related to packing material and determining the cost for shipping the packing material.

### B. Facts

The record supports the following findings of fact by a preponderance of the evidence.

1. Claim 10 involves taking into account the weight of the packing material in the cost of shipping.
2. A package to be shipped comprises an article to be shipped, a container holding the article, and may further include packing material securing the article within the container.
2. The cost of shipping a package depends on the weight of the package.
3. The weight of a package is the sum of the weights of the article to be shipped, the container holding the article, and, if present, the packing material securing the article within the container.

### C. Analysis

Claim 10 involves taking into account the weight of the packing material in the cost of shipping. It is generally well known that the cost of shipping depends on the weight of the package to be shipped, as taught in Nicholls, and that cost will necessarily be the sum of the weights of the article to be shipped, the container holding the article, and, if present, the packing material securing the article within

the container. Accordingly, it would have been obvious to consider the packing material weight in determining the shipping cost.

D. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting claim 10 over the prior art.

Claim 11

Claim 11 reads as follows:

11. The method claimed in claim 10, further including the steps of determining the weight of the packing material using the volume of the container minus the volumes of the articles in the container multiplied by the density of the packing material.

A. Issue

Appellant argues that “[t]he Examiner has not cited any art in the context of the claimed invention that shows that it would have been obvious to: determine the weight of the packing material using the volume of the container minus the volumes of the articles in the container multiplied by the density of the packing material.” Br. 21. The Examiner contends that “multiplying density by volume in order to calculate a weight is well known, hence obvious, to those of ordinary skill in the art.” Answer 7. The issue is whether it would have been obvious to one of ordinary skill in the art to determine the weight of the packing material using the volume of the container minus the volumes of the articles in the container



multiplied by the density of the packing material.

### B. Facts

The record supports the following findings of fact by a preponderance of the evidence.

1. A package to be shipped comprises an article to be shipped, a container holding the article, and may further include packing material securing the article within the container.
2. Subtracting the volume of an object from the volume of a container holding the object equals the volume of the space inside the container surrounding the object.
3. The weight of an object can be calculated by multiplying the volume of the object by its density.

### C. Analysis

Claim 11 involves determining the weight of the packing material by subtracting the volume of the article from the volume of the container and multiplying the result by the density of the packing material. It is generally well known that subtracting the volume of an object from the volume of a container holding the object equals the volume of the space inside the container surrounding the object and that the weight of an object can be calculated by multiplying the volume of the object by its density.

Accordingly, it would have been obvious to determine the weight of the packing material surrounding an article in a container by subtracting the volume of the article from the volume of the container and multiplying the result by the density of the packing material.

D. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting the claim over the prior art.

Claim 16

Claim 16 reads as follows:

16. The method claimed in claim 13, further including the steps of:  
comparing the stored weight for shipping the article and container in the completed container database with the weight determined by the carrier to ship the container; and  
querying the manufacturer of the articles and containers concerning their actual weight if the compared total weights are not the same.

A. Issue

Appellant argues that “[t]he Examiner has not cited any art in the context of the claimed invention that shows that it would be obvious to: isolate the containers that do not have the proper postage [see claim 13 on which claim 16 depends], comparing the stored weight for shipping the article and container in the completed container database with the weight determined by the carrier to ship the container;

and querying the manufacturer of the articles and containers concerning their actual weight if the compared total weights are not the same.” Br. 22.

The Examiner contends that regarding “isolating the containers that do not have the proper postage, such functionality is inherent in the prior art methods because all carriers necessarily confirm/check the weight/postage/size of the packages they receive, in order to verify that they have been paid the proper postage, and identify/return (i.e., isolate) the ones that are found to not have the correct postage.” Answer 8. Regarding “investigating to determine the correct weight when an incorrect weight is found, including inquiring of the manufacturer, determining the correct value when a value thought to be known is determined/identified as being incorrect, and inquiring of a manufacturer for the value, as well as pursuing other avenues of investigation, [the Examiner finds] such functionality is well known, hence obvious, to those of ordinary skill in the art.” Answer 8.

The issue is whether it would have been obvious to one of ordinary skill in the art to isolate containers without proper postage and querying the manufacturer of the article/container about their actual weight if it is different from their weight stored in the database.

#### B. Facts

The record supports the following findings of fact by a preponderance of the evidence.

1. Packages will not be shipped without the proper postage.

2. Customers will contact manufacturers where an item does not meet their expectations.
3. Customers will make inquiries if a product does not meet specifications.

### C. Analysis

Claim 16 is drawn to isolating containers without proper postage and querying the manufacturer of the article/container about their actual weight if it is different from their weight stored in the database.

It is generally well known that packages will not be shipped without the proper postage. Accordingly it would have been obvious to one of ordinary skill in the art to isolate containers without proper postage until such time they are provided with the proper postage to ship them.

It is generally well known that customers will contact manufacturers where an item does not meet their expectations and make inquiries if a product does not meet specifications. Accordingly, it would have been obvious for a shipper to query a manufacturer about the weight of an article/container to be shipped if their actual weight is determined to be different from their previously-recorded weight stored in a database.

### D. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting claim 16 over the prior art.

DECISION

The Examiner's rejection of claims 3 and 5-17 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

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